LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
SEP 6 1962
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1962

No. 313

RIPPLE SOLE CORPORATION,
Petitioner,

v.

AMERICAN BILTRITE RUBBER CO., INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

MELVIN R. JENNEY,
RICHARD R. HILDRETH,
CLARENCE S. LYON,
24 School Street,
Boston 8, Mass.,
Attorneys for Respondent.

BATAVIA TIMES' LAW PRINTERS,
BATAVIA, N. Y.

INDEX.

	PAGE
The Question Presented	1
Statement of the Case	2
Argument	3
There are no "Special and Important Reasons" for Review of this Case, as Specified in Rule 19 of this Court	3
The Petitioner's Attempt to Manufacture a Conflict with "Established Law" is Unavailing	4
The Petitioner's Argument that the Decision Places a Burden of Proof on a Patent Owner Contrary to Law is not Supported by the Facts of the Case	5
The District Court's Findings that the Patented Soles Had None of the Advantages Claimed for it are Amply Supported	6
Review of Findings by Court of Appeals	9
There is Ample Evidence to Support the Decision of No Patentable Invention, and the Burden of Proof is Immaterial	9
The Decision of the Courts Below in Respect to the French Patent to Lacoste is Purely Factual	10
Concurrent Findings of Fact of the Courts Below are not to be Set Aside Except Under Most Unusual Circumstances	11
Conclusion	12

INDEX OF AUTHORITIES CITED.

Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U. S. 271	11
Sinclair & Carroll Co. v. Interchemical Corp., 325 U. S. 327, 330	9
Textbook: *Supreme Court Practice* by Stern and Gressman (2nd Ed. 1954), page 107	11

IN THE

Supreme Court of the United States

October Term, 1962

No. 313

RIPPLE SOLE CORPORATION,

Petitioner,

v.

AMERICAN BILTRITE RUBBER CO., INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

The Question Presented

The sole question presented by this petition, notwithstanding the form of questions presented by the petitioner, is as follows:

Whether, in an ordinary patent case which has been decided by the District Court on its facts and the decision has been affirmed by the Court of Appeals on the ground that the District Court's findings are clearly right, this Court is to take jurisdiction for the purpose of reviewing the findings of fact.

Statement of the Case

The "Statement of the Case" appearing on pages 3-9 of the petition presents no facts or circumstances on which the petition should be granted.

This case is an ordinary patent case involving the usual factual issues of validity and infringement. Such cases are decided on the facts. No novel questions of law were presented to or decided by either the District Court or the Court of Appeals.

After a trial lasting seven court days, during which the trial judge heard the experts and other witnesses for the opposing parties, the Court handed down its decision for the defendant, accompanied by its written opinion filed March 30, 1961, reprodneed at R. 6 to 16. This opinion constitutes the District Court's findings of fact. That there were no novel issues of law presented is well shown by the citation of only a single case by the District Court (R. 15) and this cited case bore only on the question of alleged "commercial success".

The principal finding of the District Court is simply that the patent in suit is invalid because it fails to disclose any patentable invention (R. 16). Further the Court found that if there were anything which would constitute a patentable invention, it has been clearly anticipated in the prior art (R. 13). The District Court relied in particular upon a French patent to Lacoste, which is discussed in some detail in the opinion (R. 13, 14).

Upon appeal, the Court of Appeals for the First Circuit affirmed the decision of the District Court. The opinion of the Court of Appeals is quoted in the appendix to the petition for certiorari. Even a cursory reading of the

opinion of the Court of Appeals shows that the affirmance was based on a proper application of Rule 52(a) of the Federal Rules of Civil Procedure, which states, "Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses". The Court of Appeals went beyond the requirements of the rule and held that the District Court's findings were "clearly correct" and that the conclusion "of lack of invention is inescapable". Further, the Court in the final paragraph of its opinion agreed "that the patent in suit was anticipated by the French patent to Lacoste * * *".

ARGUMENT

There are no "Special and Important Reasons" for Review of this Case, as Specified in Rule 19 of this Court.

While it is recognized that Paragraph 1(b) of Rule 19 of this Court does not either control or fully measure this Court's discretion, nevertheless it sets forth the general circumstances under which petitions for certiorari to a federal court of appeals will be granted.

The "special and important reasons" referred to in Rule 19 are reasons of public importance. All patent cases are important to the litigants. There is no special importance that attaches to the Hack sole to invoke the supervisory authority of this Court to pass on mere questions of fact that have already been decided by the District Court and the Court of Appeals.

The sales figures presented in page 8 of the petition do not show importance, but lack of it. Sales of about 1,300,000 pairs of soles (in 1960) may be important to the

petitioner but such a number is obviously only a small fraction of the number of soles worn or purchased in a year by 180,000,000 people.

There is no conflict between the decision of the Court of Appeals for the First Circuit and another court of appeals in the same matter, because no other court of appeals has had occasion to pass on the patent in suit. The case does not involve an important question of federal law which has not been, but should be, settled by this Court, because the Court of Appeals was concerned only with affirming the District Court's findings of fact. By the same token, there is no conflict with applicable decisions of this Court, nor has the Court below so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

The Petitioner's Attempt to Manufacture a Conflict with "Established Law" is Unavailing.

The first part of petitioner's argument beginning at page 10 of the petition seeks to show that the First Circuit has established a rule "which is contrary to the established law". The petitioner then cites authorities bearing on the question of *utility* of a patented invention. This case has nothing to do with the question of utility; it has to do only with the question of whether the contribution made by the patentee Hack rises to the dignity of *invention*.

Petitioner's argument as to "degree of utility" is meaningless. The respondent has never questioned that the Hack sole, like any other shoe sole, has some degree of utility; if it serves to keep the wearer's bare foot from touching the ground it has a measure of utility. That is not the question decided by the District Court and Court

of Appeals in this case. The courts below decided on the facts of the case that the Hack sole did not involve such an advance in the art as to constitute a patentable invention.

Therefore, the whole argument on utility appearing on pages 10-14 of the petition is beside the point and is an effort to manufacture or contrive a conflict with established law where no conflict exists.

The Petitioner's Argument that the Decision Places a Burden of Proof on a Patent Owner Contrary to Law is not Supported by the Facts of the Case.

On pages 14-17 of its petition the petitioner argues that there is a conflict with 35 U. S. C. 282 and with the decisions of this Court by reason of the burden of proof placed on a patent owner by the decision of the Court of Appeals. This again is a manufactured conflict, presented solely in an effort to influence this Court to review the case, when no conflict does in fact exist.

No question of burden of proof is involved. The plaintiff, recognizing the necessity of showing that its alleged invention produced some advantageous results over the prior art, devoted much of its *prima facie* case to efforts to prove such advantages. The asserted advantages are catalogued in the petition which the petitioner presents to this Court.

The petitioner goes to some length to assert on pages 3 to 7 that the Hack sole has great advantages over prior soles. Thus it is claimed that the sole contributed a "new and beneficial function of forward propulsion" (page 4) that it "provides increased resiliency" and "increased comfort and reduction in shock". It is also asserted that the "forward motion of the shoe is not abruptly stopped"

(page 4). It is also claimed that there is an increase in the length of stride (page 5), that the advantages obtained occur "even without the impetus of any forward thrust of the foot", that there is "a bonus" of about 2% over conventional shoes, that a person can save up to 60 or 65 steps in walking one mile" (page 6), that "you get there with less energy" and "you save energy, there is less stress and strain on the feet and legs" (page 7).*

These assertions in the petition are nothing more than a rehash of the material presented to the trial court and reviewed by the appellate court. The advantages claimed by the plaintiff and the evidence of tests offered at the trial were fully considered by the trial judge. In his opinion the trial judge said (R. 9):

> "Plaintiff, to demonstrate and prove the mode of operation and advantages of its sole, relied on certain demonstrations at the trial and on the testimony of one Morehouse, a collaborator of Hack in the development of the sole and owner of a substantial interest in the patent, as to the results of tests conducted by him at the laboratories of the University of Southern California in Los Angeles where he is a member of the faculty."

The District Court's Findings that the Patented Soles had None of the Advantages Claimed for it are Amply Supported.

The opinion then discusses Morehouse's tests in some detail (R. 9-12). A certain "rocking test" which involved rocking back and forth on the soles was relied on heavily by the plaintiff to demonstrate "forward propulsion" but the Court found that "this test shows nothing about how this forward propulsion operates, if at all, *in actual walk-*

* The plaintiff's continued emphasis on its claim of energy saving is inexplicable, in view of the discrediting of the claim by plaintiff's own expert and the findings of the trial court. This matter will be discussed further, *infra* page 7.

ing to increase the length of one's stride" (R. 9, emphasis ours).

At R. 10-11, the Court discusses the stride length measurements. The matter of stride lengthening was emphasized by the plaintiff at the trial. The trial judge tried repeatedly to get plaintiff's expert to state what advantage there is to lengthening of the stride. There appears to be little or none, and the Court, paraphrasing Morehouse's own testimony at R. 147 found, "Morehouse himself pointed out that each individual has his own optimal length of stride at which he walks most efficiently, and that an attempt to distort this stride may result in an uneconomical expenditure of effort and energy which will prove tiring" (R. 11).

The only possible advantage that might conceivably accrue to stride lengthening would be a saving of energy expended in walking. The claim of energy saving was unquestionably the plaintiff's trump card. It was emphasized not only in the excerpts from Morehouse's testimony quoted on page 7 of the petition, but at many other places (*e.g.*, R. 80, 81, 141, 146, 199, 207, 208, 209). It is also asserted in the petition, notwithstanding that it has been completely discredited, as stated in the footnote on page 6, *supra*.

Defendant's expert Woodcock testified, without refutation, that of all of the tests in evidence in the case, only the oxygen (energy) tests would be useful as a means of evaluating one sole with respect to another (R. 340).

The District Court therefore correctly found (R. 11):

> "Ultimately, the claim for any practical advantage of a Hack sole resolves itself into a claim that the wearer can walk with less expenditure of energy."

That the whole claim of energy saving comes to nothing is amply shown by the fact that it was supported only by a single test in which Morehouse himself was the subject (Defendant's Exhibit LL, R. 106, 719, 721, 201, 206). Morehouse admitted that the differences shown by his test "would not be reliable enough * * * to give a statistically significant difference" (R. 206) and defendant's expert Woodcock testified without refutation that "there is no significance whatever in these results." (R. 339)

Therefore, the Court was amply supported by evidence in finding that plaintiff's expert Morehouse admitted that his results were not reliable enough to give a statistically significant difference (R. 11). Farther, the record includes a report of an independent investigator Karpovich (Defendant's Exhibit GG, R. 196, 565-676, introduced by stipulation, R. 29); as a result of an elaborate series of tests conducted on many subjects for the Quartermaster Research and Engineering Command of the United States Army there is stated at R. 611 a conclusion which amply supports the Court's finding that Karpovich "arrived at the conclusion that the Hack soles showed no significant difference in oxygen [energy] consumption over other soles" (R. 11, 12).

It was therefore amply demonstrated, and the District Court correctly found, that the alleged advantages of the patented sole, in so far as they were based on artificial demonstrations, such as rocking tests, were trivial and insignificant, and that the alleged advantages of the sole under actual walking conditions, such as energy saving, were nonexistent. The District Court, after weighing all of the evidence introduced both by the plaintiff and by the defendant, said that "it cannot be found that the Hack structure produces any of the advantages claimed for it" (R. 12).

Review of Findings by Court of Appeals

The Court of Appeals reviewed the facts found by the District Court. The Court said (appendix to petition, page 28):

> "Obviously the District Court was not persuaded by the testimony of the plaintiff's expert witness and the tests upon which he relied but on the contrary found the testimony of the defendant's expert based on his tests more convincing."

The Court then went on to discuss in some detail the District Court's findings relating to the various tests. It did not content itself with a *pro forma* adoption of the findings, but said (petition, page 30):

> "A careful scrutiny of the testimony and the exhibits discloses ample evidence to support the District Court's findings of fact. Indeed, we think its findings, instead of possibly being clearly erroneous, are clearly correct."

There is Ample Evidence to Support the Decision of No Patentable Invention, and the Burden of Proof is Immaterial.

It is a commonplace in the patent law that patentable invention must be predicated on some new and important contribution or advance in the art: "some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee". *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U. S. 327, 330. The factual finding that the Hack sole had none of the advantages claimed for it leads to the conclusion that Hack's innovation, if any, did not meet such a test of substantiality.

Therefore, the petitioner's argument that the courts below placed an unwarranted burden of proof on the plain-

tiff is beside the point. It is not a question of who had the burden of proof; it is simply a question of whether the sole of the patent in suit possesses any advantages over the prior art such as would entitle it to be credited with the dignity of patentable invention. It makes no difference whether the plaintiff fails to demonstrate the advantages which it claimed or whether the defendant proved that no such advantages existed. It was adequately established by evidence introduced in the trial court that the Hack sole produced no results which entitled it to be considered an invention.

Thus the argument as to burden of proof is a manufactured and contrived argument which seeks to divert this Court from the factual issues decided by the District Court and the Court of Appeals.

The Decision of the Courts Below in Respect to the French Patent to Lacoste is Purely Factual.

On pages 18-20 of its brief petitioner endeavors to make an issue of law out of the handling of the Lacoste patent by the District Court and the Court of Appeals. It is not necessary to discuss the technical details of the Lacoste patent or of the patent in suit. The District Court simply found that the Lacoste patent, as a reference in the prior art, constituted an anticipation of the patent in suit. This was purely a finding of fact, based on the patent itself and on the evidence relating thereto. It should be observed that the Lacoste patent was not offered merely as a piece of paper, but that there was substantial testimony by witnesses on both sides (Woodcock R. 312, 217-320, 366-370; Fishleigh R. 395-397, Defendant's Exhibits KKK and LLL, R. 318, 319, 745). Thus the findings of the trial court were based on its opportunity to judge of the credibility of witnesses (Rule 52(a) F. R. C. P.).

Concurrent Findings of Fact of the Courts Below are not to be Set Aside Except Under Most Unusual Circumstances.

The matters presented by this petition are squarely in line with statements made by this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271. In particular we refer to page 274 where this Court after quoting Rule 52(a) says:

> "To no type of case is this last clause [opportunity of the trial court to judge of the credibility of witnesses] more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations * * *. He [the trial judge] * * * heard many experts and other witnesses. He wrote a careful and succinct opinion and made findings covering all the factual issues.
>
> "The rule requires that an appellant court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings. These are manifestly supported by substantial evidence and the Court of Appeals found them supported by the weight of the evidence * * * A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error."

There is no showing of error in the petition. In summary, we call attention to the following statement made by Chief Justice Vinson in an address before the American Bar Association on September 7, 1949, quoted in *Supreme Court Practice* by Stern and Gressman (Second Ed. 1954) page 107, as follows:

> "The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower court decisions. In almost all cases within the Court's appellate jurisdiction, the petitioner has al-

> ready received one appellate review of his case • • • If we took every case in which an interesting legal question is raised, or our *prima facie* impression is that the decision below is erroneous, we could not fulfill the Constitutional and statutory responsibilities placed upon the Court. To remain effective, the Supreme Court must continue to decide only those cases which present questions whose resolution will have immediate importance far beyond the particular facts and parties involved."

CONCLUSION

The courts below held the patent in suit *invalid* on *each* of two independent grounds; namely, (1) lack of invention, and (2) anticipation by Lacoste. In order to prevail, the petitioner would have to show that the decisions were wrong on *both* grounds.

We submit that the decisions of the Courts were in all respects correct and that the petition for a writ of certiorari should be denied.

Respectfully submitted,

MELVIN R. JENNEY,
RICHARD R. HILDRETH,
CLARENCE S. LYON,
24 School Street,
Boston 8, Mass.,

Attorneys for Respondent.